

**REMARKS**

The Applicant has considered the Office Action dated March 31, 2006. In response, the foregoing amendments to the Specification and claims are presented, which are believed to address the Examiner's concerns, and to overcome the rejections of record. It is noted that the present amendment serves as the required submission with the Request for Continued Examination presented concurrently herewith. Additionally, a supplemental Information Disclosure Statement accompanies the present submission for the Examiner's consideration. New claim 48 is added, directed to a composition comprising the chemical compounds of the present invention. The new claim finds ample support in the Specification as filed, wherein description and discussion is provided of various compositions comprising the chemical compounds of the invention (see, for example, at least page 7, ll 5-15, page 9, ll 3-7, page 15, ll 1-10, and page 15, line 20 bridging to page 16, line 14). Accordingly, it is believed that no new matter is added.

Turning to the Office Action (page 2), the Examiner first rejects the claims under 35 USC § 112, first paragraph, and § 112, second paragraph. It is believed that the foregoing amendments address and/or render moot the rejections, and reconsideration is respectfully requested. Specifically, claim 34 and its progeny claims are canceled without prejudice, which is believed to render that portion of the rejection moot. Claim 35 has been amended to remove the terminology "any combination thereof." Similarly, the term "comprising" in claim 35 has been amended to "having" in accordance with the

Examiner's recommendation in the Office Action dated 7-7-05 (relating to now canceled claims 1-2). The dependency of claims 40-41 is believed to have been satisfactorily corrected.

Turning now to page 3 of the Office Action, the Examiner inexplicably maintains the rejection of claims under 35 U.S.C. §102(a) over the Keizer et al. article in Canadian J. Chem. (2002), Vol. 80, No. 11, pp. 1463-68 (hereinafter the Keizer et al. article). The Examiner states (page 4 of the Office Action) that the previously filed argument in support of the Rule 1.132 Affidavit is not persuasive. However, it is believed that the submitted Affidavit meets all the requirements for removal of a Section 102(a) reference, and reconsideration of the rejection is again respectfully requested.

The Affidavit made of record more than suffices to remove the Keizer et al. article as a 102(a) reference. The Affidavit establishes on its face that: (1) David A. Atwood, the present Applicant, is the sole inventor of the subject matter of the present application; (2) that the Keizer et al. article describes the Applicant's own work; and (3) Timothy S. Keizer, Lauren J. De Pue and Sean Parkin, while listed as co-authors on the Keitzer et al. article, are not inventors of any of the claimed subject matter of the present patent application. The Examiner erroneously takes the position that the Affidavit recites that "the co-authors in the above prior art are not co-authors in the instant application." This is incorrect. Rather, the Affidavit properly establishes that the co-authors of the Keizer et al. article are not co-inventors of the present application.

Section 102(a) recites as follows:

“A person shall be entitled to a patent unless -  
(a) the invention was known or used by others in this country,  
or patented or described in a printed publication in this or a  
foreign country, *before the invention thereof by the applicant*  
for patent,” (Emphasis added).

The treatment of the case of *In re Katz*<sup>1</sup> found in the MPEP is instructive in this matter (see MPEP §2132.01, page 2100-82). In that case, a Section 102(a) rejection was made based on a printed publication listing Katz and others as authors. In response, Katz submitted a declaration stating that he was the sole inventor, and that the coauthors of the publication cited in making the 102(a) rejection were working under his direction and supervision. The CCPA held that the declaration, in combination with the fact that the publication was a research paper, was enough to establish Katz as the sole inventor, and that the work described in the publication was his own.

The situation in the present application is identical. The present Applicant is the sole inventor. The co-authors of the cited publication were working under the present Applicant's direction and supervision. The work described in the publication, which is a research paper, is the Applicant's own. The submitted Affidavit establishes each of those facts. In accordance with the teachings of *In re Katz*, any presumption of inventorship

---

<sup>1</sup> *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

stemming from co-authorship is improper. Absent any evidence to the contrary, which the Examiner has not provided, the Affidavit of record is conclusive evidence that the listed inventor of the present application is the sole inventor (see the Manual of Patent Examining Procedure Section 2132.01, stating that “[T]he rejection can also be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant’s own work” and citing to *In re Katz*).

Since the Affidavit establishes that the present Applicant is the sole inventor and that the Section 102(a) reference describes the inventor’s own work, it is impossible for the present invention to have been “described in a printed publication” “before the invention thereof by the Applicant” as is required by Section 102(a). Further, as stated in *In re Katz*, any interpretation of Section 102(a) that would make a prior art patent or printed publication prior art even though the disclosure is that of applicant’s own work would negate the one year grace period afforded under Section 102(b). As stated by the CCPA, “[O]ne’s own work is not prior art under §102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under §102(a).” The rejection under Section 102(a) should be withdrawn.

It is believed that the amendments and arguments presented herein place the remaining claims of the present application in condition for allowance. Accordingly, reconsideration of the rejection of the claims, and allowance of all remaining claims of the application is respectfully requested. If any issues remain, however, the Examiner is

respectfully requested to contact the Applicants' attorney at the telephone number of record in order to expedite the prosecution of this patent application.

Respectfully submitted,

**KING & SCHICKLI, PLLC**



Patrick M. Torre  
Registration No. 55,684

247 North Broadway  
Lexington, Kentucky 40507  
(859) 252-0889

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450, on June 29, 2006

Date 6/29/06 